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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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CONNOLLY BOVE LODGE & HUTZ LLP
1875 EYE STREET, N.W.
SUITE 1100
WASHINGTON, DC 20006

EXAMINER	
NGUYEN, SON T	

ART UNIT	PAPER NUMBER
3643	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/511,717	KEMPSELL ET AL.	
	Examiner	Art Unit	
	Son T. Nguyen	3643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 September 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-46* is/are pending in the application.

4a) Of the above claim(s) *1-22* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *23-46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. **Claims 23,25-31,33,34,36-42,44** are rejected under 35 U.S.C. 103(a) as being unpatentable over Amos (914546) in view of Swain (6363698).

For claim 23, Amos teaches a saddle tree comprising a tree body 1 having a pommel end (see fig. 6, near ref. 17) and a cantle end (see fig. 6, near ref. 16 right side), the tree body being formed from a flexible resin material allowing lateral flexing of the tree (page 1, left column, line 25, resilient metal) and a generally X or V-shaped strengthening bar 14 wherein the forks of the X or V-shape are directed towards the cantle end of the saddle tree. However, Amos's strengthening bar is not Y-shaped and Amos is silent about the bar being made from carbon fibre.

It would have been an obvious substitution of functional equivalent to substitute the X or V-shaped strengthening bar of Amos with a Y- shaped strengthening bar, since a simple substitution of one known element for another would obtain predictable results, i.e. both shapes of strengthening bar would perform the same function to provide strength and rigidity to the saddle tree, and to disconnect the force if the force exists at the pommel area. KSR International Co. v. Teleflex Inc., 127 S. Ct. 1727, 1739, 1740, 82 USPQ2d 1385, 1395, 1396 (2007).

Swain teaches a saddle tree comprising a strengthening bar 8 made out of carbon fibre (col. 2, line 40). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the strengthening bar of Amos out of carbon fibre as taught by Swain, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use (for lightweight and flexibility yet rigid enough to support) as a matter of obvious choice. See Sinclair & Carroll Co. v. Interchemical Corp., 325 U.S. 327, 65 USPQ 297 (1945) and In re Leshin, 125 USPQ 416.

For claim 25, Amos as modified by Swain (emphasis on Amos) teaches wherein the pommel end of the saddle tree is angularly adjustable since the material of the saddle tree is resilient metal as disclosed on page 1, left column, line 25.

For claim 26, Amos as modified by Swain (emphasis on Amos) teaches a head plate 10 located near to the pommel end.

For claim 27, Amos as modified by Swain (emphasis on Amos) teaches wherein the head plate is malleable (see page 2, lines 14-30).

For claim 28, Amos as modified by Swain (emphasis on Amos) teaches wherein the head plate is securable in an aperture located in the saddle tree (see fig. 1, the holes where the screws are located therein to attach the plate 10 to the tree).

For claim 29, Amos as modified by Swain (emphasis on Amos) teaches wherein the head plate is formed integrally within the saddle tree. Integrally is considered as a whole unit.

For claim 30, Amos as modified by Swain (emphasis on Amos) teaches a metallic head plate but not formed from malleable steel. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the head plate of Amos out of a malleable steel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious choice. See Sinclair & Carroll Co. v. Interchemical Corp., 325 U.S. 327, 65 USPQ 297 (1945) and In re Leshin, 125 USPQ 416.

For claim 31, Amos as modified by Swain (emphasis on Amos) teaches two recessed portions, one at either side of the tree near to the pommel end, in which stirrup bars are securable. Recesses are located near ref. 8 in fig. 6.

For claim 33, Amos as modified by Swain (emphasis on Amos) teaches girth web apertures 9 located at both the pommel and the cantle end.

For claims 34, 36-42,44, Amos as modified by Swain (emphasis on Amos) teaches a saddle comprising the saddle tree above. It is inherently taught in Amos that the saddle tree is used with a saddle (see also page 2, left column, lines 25-30, where Amos states that the tree has fasteners for connection to a cover of the saddle).

3. **Claims 24,32,35,43** are rejected under 35 U.S.C. 103(a) as being unpatentable over Amos as modified by Swain as applied to claim 23 above, and further in view of Woller (5979603).

For claim 24, Amos as modified by Swain is silent about wherein the strengthening bar is made from bidirectional carbon fibre bonded with epoxy resin.

Woller teaches in the same field of endeavor of seating as Amos as modified by Swain, which Woller's seat device is made out of a known material such as a bidirectional carbon fibre bonded with epoxy resin for reinforcement in the seat (col. 5,lines 26-40). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the strengthening bar of Amos as modified by Swain out of a bidirectional carbon fibre bonded with epoxy resin as taught by Woller, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use (for lightweight and flexibility but yet stiff enough for support) as a matter of obvious choice. In re Leshin, 125 USPQ 416.

For claim 32, Amos as modified by Swain is silent about a sheet of bi-directional carbon fibre applied to at least one of the upper and lower surfaces.

Woller teaches in the same field of endeavor of seating as Amos as modified by Swain, which Woller's seat device is made out of a known material such as a sheet of bi-directional carbon fibre applied to at least one of the upper and lower surfaces for reinforcement in the seat (col. 5,lines 26-40). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the strengthening bar of Amos as modified by Swain out of a sheet of bi-directional carbon fibre applied to at least one of the upper and lower surfaces as taught by Woller, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use (for lightweight and flexibility

but yet stiff enough for support) as a matter of obvious choice. In re Leshin, 125 USPQ 416.

For claims 35 & 43, Amos as modified by Swain and Woller (emphasis on Amos) teaches a saddle comprising the saddle tree above. It is inherently taught in Amos that the saddle tree is used with a saddle (see also page 2, left column, lines 25-30, where Amos states that the tree has fasteners for connection to a cover of the saddle).

4. **Claims 45-46** are rejected under 35 U.S.C. 103(a) as being unpatentable over Amos as modified by Swain as applied to claim 23 above, and further in view of Kobe et al. (2003/0203155).

For claim 45, Amos as modified by Swain is silent about wherein the flexible resin material of the tree body is a polyurethane resin.

Kobe et al. teaches in the same field of endeavor of seating/saddle [0063] as Amos as modified by Swain, which Kobe et al. saddle is made out of a known material such as a polyurethane resin [0063][0191][0198][0205]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the flexible resin material of Amos as modified by Swain out of a polyurethane resin as taught by Woller, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use (for durability and resiliency [0191] of Kobe) as a matter of obvious choice. In re Leshin, 125 USPQ 416.

For claim 46, Amos as modified by Swain and Kobe et al. (emphasis on Amos) teaches a saddle comprising the saddle tree above. It is inherently taught in Amos that

the saddle tree is used with a saddle (see also page 2, left column, lines 25-30, where Amos states that the tree has fasteners for connection to a cover of the saddle).

Response to Arguments

5. Applicant's arguments filed 9/17/08 have been fully considered but they are not persuasive.

Applicant argued that the Office Action suggests that a Y-shaped strengthening bar may be substituted for this X-shape cushioning member because to do so would be a simple substitution of one functionally equivalent part for another. Assuming, arguendo, that both Y-shaped bars and X- shaped bars are generally known in the prior art -irrespective of use or function-the Office Action lacks a finding that a cushioning bar serves the same function as a strengthening bar. In fact, the Office Action includes no finding whatsoever as to what functions Y-shaped bars are known to serve in the prior art. Without such a finding relating to Y-shaped bars, a prima facie case of obviousness is not established over amended claim 23.

One of ordinary skill in the art studying Amos' invention would not need to be pointed out word-for-word that the cushioning member 14 functions, not only as a cushioning mechanism, but also as a strengthening mechanism because, clearly, member 14 adds strength to the tree to allow the tree to flex without breaking. Without member 14, spring action from the rider might bend the tree since there is no other reinforcement for the tree. In addition, the functionality of X-shaped versus Y-shaped, as explained in the above, are similar because, in comparing both Amos and Applicant, for

Amos, assuming a force hit in the area of the pommel near the opening in fig. 7 of Amos, the force would split and travel along the forks and lessen (due to time) as it approaches the cantle. This is the same as Applicant if a force was to hit in the area of the pommel, the force would split and travel along the forks and lessen (due to time) as it approaches the cantle. Thus, it is not clear how Applicant believes that his Y-shaped bar is any different as far as the travel path of the force along the bar, especially the non-forked area of the Y-shaped of Applicant is shown so short. In addition, Applicant's mere allegation that the strips 15 of Amos will be permanently twisted is nothing more than a mere allegation with proof or evidence. In conclusion, it is believed that the Y-shaped of Applicant (especially with the non-forked portion near ref. 106 being so short) and the X or V-shaped of Amos are functional equivalent since they both will inhibit transmission of force to the cantle over time.

Applicant argued that Swain thus teaches that steel is an appropriate material to strengthen the form of the saddle tree, and that carbon fiber is an appropriate material to provide additional flexibility to the saddle tree. Following this teaching, carbon fiber, a more flexible material, would not be considerer a suitable substitute for steel, a stiffer material, to one of ordinary skill in the art. As such, a prima facie case of obviousness is not established over amended claim 24.

Not only does the carbon fiber add flexibility to the tree but it does also function as a strengthener, and again, one of ordinary skill in the art would know this without Swain spelling out word-for-word what the function of carbon fiber is, beside flexibility.

Clearly, the material is a strong but yet flexible material which adds strength to a device. Since Amos calls for the member 14 to be resilient yet strong or rigid (such as metal) enough, the likely replaceable material that is close to resilient metal for member 14 is carbon fiber as taught by Swain. Therefore, since the material is known for its strength and flexibility, one of ordinary skill in the art would find it obvious to combine Swain's teaching of carbon fiber to be used as the preferred material in the member 14 of Amos.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son T. Nguyen whose telephone number is 571-272-6889. The examiner can normally be reached on Mon-Thu from 10:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on 571-272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Son T. Nguyen/
Primary Examiner, Art Unit 3643